

REMARKS/ARGUMENTS

Claims 53-55, 57-65, 67-73, and 75-80 are currently pending in this application, with claims 53, 61, 63, 71 and 79 being independent. No claims have been amended in this response.

Applicants respectfully request reconsideration of this application based on the following remarks.

Claim Rejections – 35 USC § 103

Claims 53-56, 61, 63-65, 71-73, and 79 are rejected under 35 USC § 103(a) allegedly as being obvious over Kolev et al. (US Patent No. 6,125,283) in view of Kaplan (US Patent No. 5,884,193).

Claims 57-59, 62, 67-69, 75-77, and 80 are rejected under 35 USC § 103(a) allegedly as being unpatentable over Kolev in view of Kaplan as applied to claims 53, 61, 63, 71 and 79 above, and further in view of Jonsson (US Patent No. 5,915,224).

Claims 60, 70, and 78 are rejected under 35 USC § 103(a) allegedly as being unpatentable over Kolev, in view of Kaplan and Jonsson as applied to claims 6, 17, and 26, above, and further in view of Sakai et al. (US Patent No. 7,010,296 B2).

Initially, it is noted that in the previous Office Action dated November 26, 2010, claims 53-80 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Kolev, Kaplan, Jonsson and Sakai. In a Response thereto filed on February 22, 2011, Applicants traversed the rejections by presenting further claim amendments and arguments. The outstanding Office Action stated on page 25 that “Applicant’s arguments with respect to claims 53-55, 57-65, 67-73, and 75-80 have been considered but are moot in view of the new ground(s) of rejection necessitated by the new claims.” Applicants presume that the “new ground(s)” indicated in the Office Action refers to “determining whether the dialing string indicates an emergency number and, if the dialing string indicates an emergency number, generating a first marking without regard to any user-defined permission information to indicate that the call is allowed on each of the plurality of communications networks; if the dialing string does not indicate an emergency number, accessing, for each of the plurality of communications networks, user-defined permission information and comparing the dialing string to the user-defined permission information to determine if the call is allowed or is not allowed on each of the plurality of

communications networks ...,” as substantially similarly recited by previously amended independent claims 53, 61, 63, 71 and 79.

However, the outstanding Office Action again rejected claims 53-55, 57-65, 67-73, and 75-80 under 35 USC §103(a) as allegedly being unpatentable over Kolev, Kaplan, Jonsson and Sakai without responding to the clear traversal presented in Applicants’ previous Response filed February 22, 2011. This failure to answer the substance of Applicants’ arguments renders the Office Action incomplete as to all matters, as is required by 37 C.F.R. § 1.104(b). Further, MPEP § 707.07(f) states that “[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide **clear explanations of all actions** taken by the examiner during prosecution of an application” (emphasis added). “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and **answer the substance of it**” (*Id.*, emphasis added). “The examiner must address all arguments which have not already been responded to in the statement of the rejection.” (MPEP § 707.07(f), Examiner Note 1).

In the present case, the outstanding Office Action essentially repeated the rejections presented in the previous Office Action and failed to address Applicant’s clear traversals. In fact, none of Applicants’ arguments were specifically addressed in the outstanding Office Action. For example, the Examiner has not responded to the Applicants’ arguments with respect to the argument that there is nothing in the cited portions of Kolev that discloses or suggests that subscriber identification information stored in a SIM card can be manipulated or programmed by each individual user.¹ Further, the Examiner fails to address Applicants’ contention that proposed combination of Kolev and Kaplan is not valid, because modifying Kolev by the teachings of Kaplan violates the principle of operation of Kolev.² In addition, the Examiner appears non-responsive to Applicants’ argument that Kolev is completely silent with respect to “**generating a first marking** indicating that the call is allowed on each of the plurality of communications networks if the dialing string indicates an emergency number,” as recited by independent claims 53, 61, 63, 71 and 79.³

It is respectfully submitted that failure to specifically respond to Applicant’s arguments renders the Office Action arbitrary and capricious, and therefore invalid under the

¹ See, e.g., Response filed February 22, 2011, pages 15-16.

² *Id.*, pages 16-17.

³ *Id.*, page 17.

Administrative Procedure Act (5 U.S.C. § 706), a standard to which all Actions by the USPTO must adhere (see *Dickenson v. Zurko*, 527 U.S. 150 (1999)).

Applicants respectfully request that the Examiner address the substance of Applicants' arguments in the next Office Action. Further, Applicants respectfully note that at least because the outstanding Office Action is incomplete under 37 C.F.R. § 1.104(b) and does not meet the requirements of MPEP § 707.07(f), a next Action in this case cannot be made final.

Next, Applicants reiterate the arguments presented in the previous response filed on February 22, 2011 as follows as a full and complete response to the outstanding Office Action. Favorable reconsideration and further examination of the pending claims 53-55, 57-65, 67-73, and 75-80 is respectfully requested.

Applicants respectfully traverse the rejections in the Office Action dated April 5, 2011, as none of the cited references disclose or suggest each and every element claimed in present application.

To establish a *prima facie* case of obviousness, all of the claimed features must be taught or suggested by the references and there must be some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See, e.g., *KSR International Co., v. Teleflex Inc.*, No. 04-1350, (US, April 30, 2007).

Initially, independent claim 53 recites, in part, that “[a] method of communications, comprising: ... determining whether the dialing string indicates an emergency number and, if the dialing string indicates an emergency number, generating a first marking without regard to any user-defined permission information to indicate that the call is allowed on each of the plurality of communications networks; if the dialing string does not indicate an emergency number, accessing, for each of the plurality of communications networks, user-defined permission information and comparing the dialing string to the user-defined permission information to determine if the call is allowed or is not allowed on each of the plurality of communications networks”

Kolev does not disclose or suggest “comparing the dialing string to the user-defined permission information to determine if the call is allowed or is not allowed on each of the plurality of communications networks.”

On page 4 of the Office Action, the Examiner appears to equate the information stored in

Kolev's memory (68) and Subscriber Identity Module (SIM) (72) to the claimed element "user-defined permission information" in claim 53.

Applicants respectfully disagree because there is nothing in the cited portions of Kolev that discloses or suggests that subscriber identification information stored in a SIM card can be manipulated or programmed by each individual user. Rather, Kolev states that the SIM card contains a subscriber identity which is used to control access to the satellite and terrestrial communication networks. See, Kolev, Col. 2, lines 42-45 and Col. 6, lines 36-41. Accordingly, Kolev discloses that the SIM card stores network-specific information, i.e. the subscriber identity, used to authenticate and identify subscribers on the network, and, as is well known to one of skill in the art, this information *is not* "user-defined permission information," as claimed herein claim 53. As such, the assertion in the Office Action that the information stored in Kolev's SIM card or memory reads on the claimed element "user-defined permission information" in claim 53 is incorrect and not factually supported.

Further, Kolev explicitly discloses initiating a subscriber identity check in response to receiving a request for placement of an emergency call. In this regard, Kolev states at col. 9, line 54 to col. 10, line 4 that:

Finally, an emergency call request from the user during satellite mode operations, as illustrated at block 112, initiates a check for the presence of a valid subscriber identity at block 114. If a valid subscriber identity is detected at block 114, the emergency call is processed in satellite mode as illustrated at block 116. At block 118, the emergency call is processed in terrestrial mode if the SIM is determined to be invalid at block 114.

As illustrated in the embodiment of FIG. 6, emergency calls may be immediately processed in terrestrial mode without awaiting confirmation of a switch from the user. This is a preferred method of operation as it provides the fastest possible access to the terrestrial mode network for placement of the emergency call. However, operations at block 118 may provide a notification to the user that no valid subscriber identity is present and request user confirmation of a switch to terrestrial mode before placing the emergency call. (Emphasis added)

That is, Kolev expressly discloses checking the validity of the subscriber's identity registered in a SIM card or a memory when an emergency call is requested by a user. In the event of detecting an invalid subscriber identity, the emergency call is processed in the terrestrial mode, as opposed to the normal satellite mode for a valid identity. In other words, by verifying each subscriber's identity stored in, e.g., a SIM card, Kolev switches between celestial wireless and

conventional terrestrial networks.

Therefore, Kolev teaches checking the validity of each subscriber's identity to determine if a call is allowed or is not allowed on each of the plurality of communications networks. Kolev's disclosure does not concern comparing a dialing string to the identity information stored in the memory or SIM card.

Additionally, it is noted that the Examiner admits that Kolev does not specifically disclose "user-defined permission information comprises at least one of a fixed dialing list indicating one or more phone numbers allowed on a particular communications network or a block list indicating one or more phone numbers that are not allowed on a particular communications network, wherein the fixed dialing list and the block list are programmed by a user into a communications card within the communications device," as also claimed in claim 53, but tries to cure this deficiency by citing Kaplan at Col. 5, lines 2-33. See, Office Action, page 5.

Applicants respectfully disagree. Kaplan at the cited portion discloses allowing a user to store user-selectable destination telephone numbers and saving these numbers in an override storage area. The proposed combination of Kolev and Kaplan is not valid, however, as modifying Kolev by the teachings of Kaplan violates the principle of operation of Kolev. Specifically, the operation of the device of Kolev is based on the principle that a call is not made unless a SIM contains a valid subscriber identity, which is **NOT** user-programmed or user-selected information. In particular, as known to one of ordinary skill in the art, a subscriber identity is typically provided and managed at a network system or operator level. Modifying Kolev to operate so that user-defined information would allow a call to be originated would allow a user to self-define a destination number and essentially allow a call to any destination number to be made. Such a modification defeats the principle of operation of Kolev, which teaches that a call should be restricted based on information that is not programmed or defined by the user, e.g. valid subscriber information, but instead on a network-defined subscriber identity. Thus, the modification of Kolev by the teachings of Kaplan is improper, and therefore the Office Action has failed to make a prima facie rejection under 35 USC 103.

In addition, in rejecting the portion of claim 53 that includes the above-noted subject matter, the Examiner appears to rely on the teachings of Kolev at col. 8, lines 5-13 and col. 9, lines 53-54 and 61-66. See, Office Action, pages 3-4. However, Applicants respectfully submit

that Kolev fails to teach or suggest the recited subject matter.

Specifically, at the cited portions, Kolev merely discloses initiating a check for the presence of a valid subscriber identity upon receiving an emergency call request. Kolev is completely silent with respect to “*generating a first marking* indicating that the call is allowed on each of the plurality of communications networks if the dialing string indicates an emergency number,” as required by claim 53.

Secondary references Kaplan, Jonsson and Sakai, individually or in combination with Kolev, fail to disclose or suggest at least the aforementioned features, as recited in independent claim 53. Claim 53 is thus patentable over cited references. Independent claims 61, 63, 71 and 79 recite similar subject matter, and also are patentable for at least the reasons discussed above in claim 53.

Dependent claims 54, 55, 57-60, 62, 64, 65, 67-70, 72, 73, 75-78 and 80 depend from independent claims 53, 61, 63, 71 and 79, respectively, and therefore, also define patentable subject matter.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejections of pending claims under 35 USC § 103(a).

CONCLUSION

In light of these remarks, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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